

PATENT

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05-18-05

Date


Joanne Bourguignon

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Ted Eugene Wright

Serial No. 09/499,069

Filed: February 4, 2000

For: SINGLE-SHEET REGISTRATION FORM AND KEY PACKET

Examiner: Monica Smith Carter

Group Art Unit: 3722

Docket No. 35008.001

Date: May 18, 2005

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents,
P.O. Box 1450,
Alexandria, VA 22313-1450

TRANSMITTAL OF SUPPLEMENTAL REPLY BRIEF

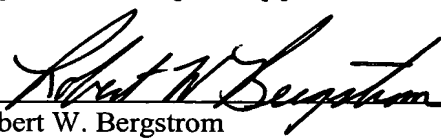
Sir:

Transmitted herewith in triplicate is the Reply Brief with respect to the Examiner's Answer mailed on March 18, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

No fee is required for filing of this Reply Brief.

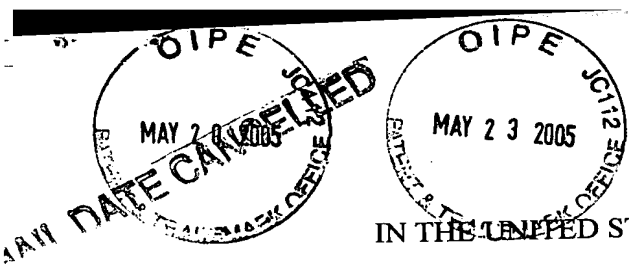
If any fees are required, please charge Deposit Account No. 50-2976.

Respectfully submitted,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Inventors: Ted Eugene Wright

Serial No. 09/499,069

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SUPPLEMENTAL REPLY BRIEF TO CORRECT
REPLY BRIEF FILED UNDER 37 CFR 1.193(b)(1)

Mail Stop Board of Patent Appeals and interferences
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated March 18, 2005, applicant replied in a Reply Brief sent earlier on the same day, and more correctly replies, in the current, Supplemental Reply Brief, as follows:

REAL PARTY IN INTEREST

Electronic Forms Plus, Inc., is the Assignee of the present patent application. Electronic Forms Plus, Inc., is a California corporation with headquarters in San Diego, California.

RELATED APPEALS AND INTERFERENCES

Applicant's Representative has not identified, and does not know of, any other appeals of interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF AMENDMENTS

No Amendment After Final is enclosed with this brief. The last Response was filed. The last amendment to the claims was filed.

SUMMARY OF CLAIMED SUBJECT MATTER

Overview

The claimed invention is a single-sheet registration form and key packet intended for use in hotels, motels, and other such businesses in which guests or customers are registered and provided with keys. The single-sheet registration form and key packet is preprinted with general information. As described in the Detailed Description of the Invention section of the current application, in text referencing Figures 5-9, at the time that a guest or customer is registered, a clerk may obtain registration information from the guest, type that information into a form displayed by a computer, and print the information, or a subset of the information, onto the single-sheet registration form and key packet via a laser printer or other printing device interconnected with the computer in order to produce a completed registration form and key packet. The computer may use knowledge of the format of preprinted information in order to print additional information related to a particular guest or time sensitive information onto the preprinted single-sheet registration form and key packet. Following printing of the single-sheet registration form and key packet, the clerk, in one step, separates the registration form from the key packet along a line of perforations, and provides the registration form for the guest's signature. The clerk then quickly assembles the key packet in two steps by folding along two lines of perforations, inserts one or more room keys into slots dye-cut into the key packet, and hands the assembled key packet to the guest.

Figure 2 of the Current Application shows a single-sheet-registration-form-and-key-packet blank, prior to initial printing. The single-sheet-registration-form-and-key-packet blank includes a perforated, vertical fold line, a horizontal line of perforations 204 separating the registration form 206 from the key packet 208, a horizontal perforated fold line 210, and dye-cut slots 212 and 214 for a magnetic key card and metal key, respectively. Figure 3 of the Current Application shows the single-sheet registration form and key packet following initial printing – commonly offset printing – to produce a preprinted single-sheet-registration-form-and-key-packet form. Preprinted single-sheet-registration-form-and-key-packet forms are loaded into a printer interconnected with a desk computer, and are printed

with particular guest information and time-sensitive information, as shown in Figure 4 of the Current Application. The registration form is separated from the key packet, as shown in Figure 5 of the Current Application. The key packet is then folded along the horizontal, perforated fold line, as shown in Figure 6 of the Current Application, and then folded along the vertical, perforated fold line to produce the completed key packet, as shown in Figure 8 of the Current Application.

Example preprinted single-sheet-registration-form-and-key-packet forms were provided, in Exhibit D, in an Amendment filed on August 5, 2002, to provide definitive illustration of the claimed invention.

Independent Claim 1

Independent claim 1 claims a rectangular, single-sheet registration form and key packet as shown in Figures 2-4 of the Current Application, comprising a registration form, an unfolded key packet separated from the registration form by a line of perforations, and one or more die-cut slots in the unfolded key packet.

Dependent Claims 2 – 7

Dependent claim 2 claims the rectangular, single-sheet registration form and key packet with pre-printed information, as shown in Figure 3 of the Current Application. Dependent claim 3 claims the rectangular, single-sheet registration form and key packet with pre-printed information, as shown in Figure 3 of the Current Application, which is printed on by a printing device. Dependent claim 4 claims the rectangular, single-sheet registration form and key packet with pre-printed information and additional information printed by the printing device, as shown in Figure 4 of the Current Application. Dependent claims 5 and 6 adds additional details regarding the dimensions of the rectangular, single-sheet registration form and key packet and the placement of the registration form with respect to the unfolded key packet. Dependent claim 7 adds details about the types of keys stored in the key packet.

Independent Claim 11

Independent claim 11 claims a single sheet dimensioned to feed through a commercially available computer printer that includes a registration form, an unfolded key packet separated from the registration form by a line of perforations, and one or more die-cut slots in the unfolded key packet.

Dependent Claims 12 – 15

Dependent claim 12 adds details related to the material composition to the single-sheet registration form and key packet of claim 11. Dependent claim 13 claims the single-sheet registration form and key packet with pre-printed information, as shown in Figure 3 of the Current Application. Dependent claim 14 claims the rectangular, single-sheet registration form and key packet with pre-printed information, as shown in Figure 3 of the Current Application that is printed by a printing device. Dependent claim 15 claims the rectangular, single-sheet registration form and key packet with pre-printed information and additional information printed by the printing device, as shown in Figure 4 of the Current Application.

Independent Claim 16

Independent claim 16 claims a single sheet with dimensions, texture, and moisture contents that allow the single sheet to feed through a commercially available computer printer, the single sheet including a registration form, an unfolded key packet separated from the registration form by a line of perforations, and one or more die-cut slots in the unfolded key packet.

Dependent Claims 17 – 21

Dependent claim 17 adds details related to the material composition to the single-sheet registration form and key packet of claim 16. Dependent claim 18 claims the single-sheet registration form and key packet with pre-printed information, as shown in Figure 3 of the Current Application. Dependent claim 19 claims the single-sheet registration form and key packet with pre-printed information, as shown in Figure 3 of the Current Application that is printed by a printing device. Dependent claim 20 claims the single-sheet registration form and key packet with pre-printed information and additional information printed by the printing device, as shown in Figure 4 of the Current Application. Dependent claim 21 claims a rectangular, single-sheet registration form and key packet.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether the Examiner has offered substantial new grounds for rejection, in the Office Action of June 4, 2004, which would supplement or eclipse the issues already identified in

the Appeal Brief originally filed by Applicants on March 5, 2004.

2. Whether the Examiner can reject claims directed to Applicant's registration form and key packet under 35 U.S.C. § 103(a) when an extensive declaration accompanied by evidence for commercial success, copying by others, and attempts by customers to remove the "Patent Pending" notice from Applicant's claimed registration form and key packet have been twice submitted by Applicant with extensive explanation, and yet have been neither substantively responded to, nor apparently substantively considered, by the Examiner.

3. Whether the currently claimed invention is anticipated by, or made obvious by, any of Thompson, U.S. Patent No. 3,655,119, Skelton, U.S. Patent No. 4,850,611, or Crowell, U.S. Patent No. 4,592,573 alone, or in any combination.

ARGUMENT

Claims 1-7 and 11-21 are currently pending in the Current Application. In an Office Action dated October 6, 2003 ("Originally Appealed Office Action"), the Examiner rejected claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by Thompson, U.S. Patent No. 3,655,119 ("Thompson"), rejected claims 2 and 5 under U.S.C. § 103(a) as being unpatentable over Thompson, and rejected claims 3, 4, and 11-21 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Crowell, U.S. Patent No. 4,592,573 ("Crowell"). Claim 6 was objected to as being dependent upon a rejected base claim, but the Examiner indicated that claim 6 would be allowable if rewritten in independent form.

In an Office Action dated June 4, 2004 ("Most Recent Office Action"), the Examiner reopened prosecution, and rejected claims 1-5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Skelton, U.S. Patent No. 4,850,611 ("Skelton"), and rejected claims 11-21 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Skelton and further in view of Crowell. Claim 6 was not specifically mentioned in the Most Recent Office Action, but the Office Action Summary listed claims 1-21 as rejected. Therefore, Applicant's Representative assumed that claim 6 was rejected.

Applicant respectfully disagrees with these rejections.

ISSUE 1

1. Whether the Examiner has offered substantial new grounds for rejection, in the Office Action of June 4, 2004, which would supplement or eclipse the issues already identified in the Appeal Brief originally filed by Applicants on March 5, 2004.

In the Appeal Brief filed on March 5, 2004, Applicant's Representative argued that the Examiner did not offer substantial new grounds for rejection in the Office Action of June 4, 2004, and that, therefore, appeal of the rejections in the Originally Appealed Office Action should be maintained. In response to Applicant's Representative's arguments, in the Examiner's Answer, beginning at the bottom of page 8 and continuing to the top of page 10, the Examiner summarizes rejections contained in four Office Actions related to the current application, prior to Applicant's filing of a continuing prosecution application on August 5, 2002, and further summarizes the rejections contained in four additional Office Actions issued after filing of the continuing prosecution application. According to the Examiner's summary, the reference "Thompson" has been cited in seven separate rejections in three Office Actions, the reference "Skelton" has been cited in 14 separate rejections in six different Office Actions, and the reference "Crowell" has been cited in two separate rejections in two Office Actions. The reference "Skelton" has been used as the primary reference for rejection of claims 1-6 five times, and the reference "Thompson" has been used as the primary reference for rejections of claims 1-5 twice. The reference "Skelton" has been twice used as the primary reference in rejecting claims 11-15, and the reference "Thompson" has twice been used as the primary reference in rejecting claims 11-15. The reference "Crowell" has been twice included as a secondary reference in the rejection of claims 11-15.

Applicant's Representative has been arguing the patentability of Ted Wright's single-sheet registration form and key packet over the Skelton and Thompson references for almost five years, in at least five different Responses and Amendments. While it is true that the rejections contained in the Most Recent Office Action represent different combinations of these three cited references than the combinations used in the rejections contained in the Originally Appealed Office Action, and while it is true that, from a combinatoric standpoint, many additional permutations and combinations of the cited references "Thompson," "Skelton," and "Crowell" remain to be asserted, Applicant's Representative respectfully submits that, in view of the lengthy prosecution of the current application, eight Office Actions, and multiple citations of the three references "Thompson," "Skelton," and "Crowell," the Examiner has not offered substantial new grounds for rejection in the Most Recent Office Action, and that appeal of the rejections in the Originally Appealed Office Action should be maintained. Moreover, Appellant's company is not a large entity, and

continued prosecution of various combinations and permutations of the repeatedly cited references would be an unfair burden in both time and expense. Finally, as discussed below, the claimed invention is neither anticipated by, nor made obvious by, any of the cited references, alone or in combination.

ISSUE 2

2. Whether the Examiner can reject claims directed to Applicant's registration form and key packet under 35 U.S.C. § 103(a) when an extensive declaration accompanied by evidence for commercial success, copying by others, and attempts by customers to remove the "Patent Pending" notice from Applicant's claimed registration form and key packet have been twice submitted by Applicant with extensive explanation, and yet have been neither substantively responded to, nor apparently substantively considered, by the Examiner.

In the Originally Filed Appeal Brief, Applicant's Representative argued that the Examiner has not substantively responded to, or apparently substantively considered, the extensive Declaration, accompanied by evidence, for commercial success, copying by others, attempts by customers to remove the "patent pending" notice from Applicant's claimed single-sheet registration form and key packet, and long-felt need. In the Examiner's Answer to the Originally Filed Appeal Brief, the Examiner disagrees, briefly reviewing the Examiner's response to the Declaration and evidence on paragraph 10, and then offering new reasons for concluding that the Declaration and evidence are insufficient to establish commercial success, beginning on line 5 of page 10 and continuing to line 3 of page 11.

In the Originally Filed Appeal Brief, Applicant's Representative furnished a lengthy review of Applicant's Representative's written exchanges with regard to the evidence of commercial success and other objective evidence of non-obviousness originally furnished on August 5, 2002. In the interest of brevity, Applicant's Representative briefly summarizes the exchanges with regard to objective evidence of non-obviousness, and respectfully refers the Appeal Board to the Originally Filed Appeal Brief and the prosecution history for additional details.

Applicant's Representative first introduced the objective evidence of non-obviousness in a Response, dated February 12, 2001. In the subsequent Office Action, dated April 27, 2001, the Examiner did not mention Applicant's reference to the objective evidence of non-obviousness. In a Response filed July 27, 2001, Applicant's Representative again

referred to the commercial success, copying by others, attempts to remove patent pending labels, and long-felt need. The Examiner again did not reply to Applicant's Representative's discussion of commercial success, copying by others, attempts to remove patent pending labels, and long-felt need in the subsequent Office Action, dated October 9, 2001. A Declaration and evidence for commercial success, copying by others, attempts to remove patent pending labels, and long-felt need were filed by Applicant's Representative at the time of filing the continuing prosecution application on August 5, 2002. In a subsequent Office Action, dated August 27, 2002, the Examiner rejected the Declaration and evidence on the basis that the Examiner felt that the Declaration and evidence referred only to "the system described in the above-referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of non-obviousness is commensurate in scope with the claims." For this proposition, the Examiner cited M.P.E.P. § 716. Apparently, the Examiner was referring to M.P.E.P. § 716.02(d) or § 716.03(a). In a subsequent Response, filed November 27, 2002, Applicant's Representative pointed out that Applicant is not claiming a system, but is instead claiming a single-sheet registration form and key packet, and that the Declaration clearly stated that the sales figures and other evidence were relevant to the single-sheet registration form and key packet representing an embodiment of the claimed invention. Furthermore, the Declaration was amended to replace the term "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET" with the phrase "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15" in order to make it abundantly clear that the Declaration and evidence are, in fact, directly related to the claimed single-sheet registration form and key packet claimed in the Current Application. Puzzlingly, in a subsequent Office Action, the Examiner continued to reject the Declaration and objective evidence for referring only to a described system and for not showing objective evidence commensurate in scope with the claims. In an Office Action issued February 21, 2003, the Examiner included a rather strange citation of 37 C.F.R. § 1.132, including a detailed Examiner note and an apparent template for declaring an Affidavit or Declaration insufficient, and then stated:

The Declaration is directed to how the invention was reduced to practice and the continued diligence of the invention and not to how the claims are non-obvious over the cited references. The submitted correspondence, purchase orders, sample forms, and other materials fail to distinguish the claimed invention from the references upon which the rejections are based. The provided material dates back to the summer of 1998. The references used in the rejections were patented more than one year prior to filing with

the original patent application (May 20, 1999). Therefore, the Examiner maintains that the Declaration is insufficient to overcome the rejections of record.

In addition to being largely indecipherable, the cited material and the Examiner's comments again point to a failure on the part of the Examiner to appreciate the importance and legal significance of the Declaration and evidence supplied by the Applicant. The Examiner continues to mistakenly conclude that the Declaration and objective evidence must address specific references cited by the Examiner, when in fact the Declaration and objective evidence point to the non-obviousness of Applicant's claimed invention in general, showing commercial success, copying by others, attempts to remove patent pending labels, and long-felt need. This objective evidence necessarily involves purchase orders, competitor's order forms, and the many other pieces of evidence provided. This evidence has nothing to do with the Examiner's cited references, and is not provided in order to overcome them.

In a Response filed on May 23, 2003, Applicant's Representative again pointed out to the Examiner that the Declaration and objective evidence were entirely commensurate with the scope of the claims, and attempted to convince the Examiner of the importance of the Declaration and objective evidence, and of the Examiner's obligation to substantively consider the Declaration and objective evidence. Please note that, at this point in time, over a year had elapsed since for commercial success, copying by others, attempts to remove patent pending labels, and long-felt need was first introduced to the Examiner's attention, nine months had elapsed since a formal Declaration and objective evidence were submitted, and four Office Actions related to the Current Application had been issued. In Applicant's Representative's respectfully submitted opinion, the Examiner had failed to substantively consider the submitted Declaration and objective evidence.

In the Originally Appealed Office Action, the Examiner, in response to Applicant's Representative's arguments, stated that: "The Declaration filed August 5, 2002, along with exhibits filed July 21, 2002, have been reviewed; however, this issued is moot in view of the newly cited rejections below." Applicant's Representative respectfully submits that this statement clearly indicates a failure by the Examiner to appreciate the importance and legal relevance of the Declaration and evidence of for commercial success, copying by others, attempts to remove patent pending labels, and long-felt need. Such evidence is not made moot by a subsequent, insubstantially different, 35 U.S.C. § 103 rejection. In Applicant's representative's opinion, objective evidence of non-obviousness is independent of

the specific combinations and permutations of cited references used to craft a 35 U.S.C. § 103 rejection, but instead indicates that an invention is non-obvious over any one or combination of references. Commercial success, for example, remains commercial success, regardless of which references are cited by an Examiner in a 35 U.S.C. § 103 rejection. Thus, at the time of the originally filed Appeal Brief, Applicant's Representative respectfully submits that the Declaration and objective evidence of non-obviousness had still not been substantively considered by the Examiner. In the Most Recent Office Action, issued by the Examiner upon re-opening prosecution, the Examiner states:

Applicant argues that the Examiner has failed to substantively consider or respond to the previous Declaration. The Examiner disagrees and asserts that the Declaration was reviewed and addressed in the previous Office Action mailed October 6, 2003. Further, the Examiner continues to maintain that the Declaration is insufficient to overcome the rejections as set forth above.

Thus, the Examiner states that declaring the Declaration and objective evidence of non-obviousness as being moot in view of newly crafted 35 U.S.C. § 103 rejection constituted a review and addressing of the Declaration and evidence of objective evidence of non-obviousness. Again, Applicant's Representative respectfully submits that this failure to appreciate the significance of, and to substantively address, the Declaration and objective evidence of non-obviousness is a clear error on the part of the Examiner.

In the Examiner's Answer to the Supplemental Appeal Brief filed on October 4, 2004, the Examiner re-states the rejection of the Declaration and evidence, and adds new reasons for considering the Declaration and evidence insufficient, as follows:

As seen in the Office Actions mailed August 27, 2002, February 21, 2003, and October 06, 2003, the Declaration and exhibits submitted August 5, 2002, May 27, 2003, and July 21, 2003 . . . were considered and a response was submitted. The Examiner stated that the Declaration was insufficient to overcome the rejection since it referred only to the system described in the application and did not address the individual claims.

The Examiner continues to maintain that the Declaration is insufficient to overcome the currently set forth rejections. Appellant states that the Declaration provide evidence of commercial success. Appellant has failed to successively establish commercial success hence Appellant failed to provide cost information associated with Appellant's product as compared to the cost of other products provided by their competitors. Appellant has merely established commercial usability, not commercial success as asserted by Appellant.

Furthermore, Appellant's Declaration does not address the obviousness rejections as set forth in the Office Action. Appellant's Declaration addresses the commercial success of the product and does not address the patentability of the presently claimed invention. As stated above, Appellant has failed to adequately provide evidence of commercial success.

The Declaration, as repeatedly pointed out by Applicant's Representative, explicitly and repeatedly refers to the "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15 of Continuation Prosecution Application number 09/499,069." Neither the Declaration nor the current claims refer to a "system." The Current Application uses the word "system" only to refer to a computer system that may be used by a hotel clerk, and not once characterizes the present invention as being directed to a system. Applicant's Representative is at a loss to understand the Examiner's continued insistence that the Declaration refers "only to the system described in the application and [does] not address the individual claims." Please note that all of claims 1-7 and 11-15 include the phrase "single-sheet registration form and key packet" at the very beginning of the claim. The Declaration explicitly and unambiguously refers to the single-sheet registration form and key packet that is claimed in the current claims.

The Examiner provides no citation to either the M.P.E.P. or case law for the proposition that a Declaration and evidence of commercial success needs to provide cost information associated with Appellant's product as compared to the cost of other products provided by their competitors. Applicant's representative cannot understand this being relevant to commercial success in the current case. However, regardless of whether or not this information is relevant, this information was included in the submitted Declaration and objective evidence of non-obviousness. In the Declaration originally submitted on August 5, 2002, and re-submitted in amended form on November 27, 2002, Ted Wright clearly states the number of units and the total sales revenue for his single-sheet registration form and key packet, in Section 2 of the Declaration, for the years 2000, 2001, and for the first five months of 2002. A simple division of the total sales revenue of \$177,500 by the number of units sold, 5,017,429, for the first five months of the year 2002 reveals a price per unit of 3.5 cents. Also in the evidence furnished with the Declaration, there is an order form produced by Focus Services that shows a price of 4.28 cents per key folder, their term for the single-sheet registration form and key packet, and, additionally, there is an order form from USFI that shows a price of \$755 for 24,000 registration form and key packets which, after a simple division, reveals a price of 3.1 cents per registration form and key packet. All of this

evidence was clearly set forth in section 3 of the Declaration and Exhibit A.

With regard to establishment of commercial usability versus commercial success, Applicant's Representative confesses to being completely bewildered. First, the Examiner provides no legal citation or reference for the notion of commercial usability, for the relevance of the difference between commercial usability and commercial success, and any indication that such considerations are needed in evaluation of evidence of commercial success. Second, for a small business to immediately achieve sales of over \$200,000 in the first year of selling a new product, to increase those sales by over 50 percent in the next year, and to additionally increase the sales rather spectacularly in the first five months of the year after, is an unambiguous and clear case of commercial success for anyone involved in, conversant with, or appreciative of small business. In the first five months of the year 2002, Ted Wright sold over 5,000,000 single-sheet registration forms and key packets. Assuming thickness of 0.15 millimeters for a single-sheet registration form and key packet, a stack of 5,000,000 single-sheet registration form and key packets would be 750 meters tall, far taller than the tallest skyscraper, and a height equivalent to that of a small mountain.. Applicant's representative respectfully suggests that, by any measure, sales of such quantities of a paper product represent commercial success.

With regard to the Examiner's continued insistence that the Declaration and objective evidence of non-obviousness do not address the patentability of the presently claimed invention, Applicant's representative again observes that, first, the Examiner has yet to cite relevant references, and, second, whether or not relevant references have been cited by the Examiner, the Declaration and objective evidence for non-obviousness are not intended to refute the Examiners specific claim rejections, but instead to demonstrate commercial success, copying by others, attempts to remove patent pending labels, and long-felt need, all of which are completely independent of, and orthogonal to, any of the cited references. The cited references are directed to a ticket envelope, a coupon envelope, and a novelty stationery. The commercial success of Applicant's single-sheet registration form and key packet is completely unrelated to ticket envelopes, coupon envelopes, and novelty stationery items that have never been, and likely will never be, used as a registration forms and key packets, have never been purchased by anyone for such a use, and would be completely unsuitable for such a use. Applicant's Representative has filed at least five Responses and Amendments, an Appeal Brief, and a Supplementary Appeal Brief in which Applicant's Representative has repeatedly addressed the patentability of the presently claimed invention with respect to the cited references. Moreover, the Declaration filed on November 27, 2002,

specifically states:

I declare that I am the named inventor in the above-identified patent application. Submitted herewith are statements of fact and documentation that demonstrate that my single-sheet registration form and key packet, as claimed in claims 1-7, 11-15 of the continuation prosecution application number 09/499,069, is non-obvious in light of the references cited by the Examiner and arguments made the Examiner during prosecution of U.S. Patent Application No. 09/499,069 in a continuation prosecution application.

Applicant's Representative would like to also to respectfully point out that the Declaration and evidence of non-obviousness included evidence of copying by others, to attempts to remove patent pending labels from Appellant's product, and to long-felt need, in addition to evidence for commercial success, and none of this evidence of non-obviousness has yet been considered or addressed by the Examiner.

Again, Applicant's Representative would like to respectfully point out that Ted Wright's company is not a large entity, and that years of prosecution in which properly furnished evidence of commercial success, copying by others, and long-felt need have failed to be substantively considered by the Examiner, based on erroneous statements and conclusions, represents an unfair financial burden, and unfairly prolongs issuance of a patent to protect Ted Wright's invention. Furthermore, Applicant's representative is respectfully amazed that both the Examiner, and the two Supervisory Examiners that signed the Examiner's Answer, would have allowed a clearly false statement regarding the lack of price information to be included in any official correspondence from the USPTO, and particularly at this late stage of the Appeal Process. It is, in Applicant's Representative's respectfully offered opinion, likely that neither the Examiner nor the two Supervisory Examiners have ever read or considered the Declaration and objective evidence of non-obviousness. A copy of the Declaration is included with this Reply Brief as an Appendix, with relevant portions bolded or bolded and underlined.

ISSUE 3

3. Whether the currently claimed invention is anticipated by, or made obvious by, any of Thompson, U.S. Patent No. 3,655,119, Skelton, U.S. Patent No. 4,850,611, or Crowell, U.S. Patent No. 4,592,573 alone, or in any combination.

Applicant's Representative has been arguing the patentability of the current

invention over the cited references "Thompson" and "Skelton" for over four years. Extensive arguments related to "Thompson" and "Skelton" appear throughout the prosecution history of the current application, as well as in the Originally Filed Appeal Brief and the Supplemental Appeal Brief. Arguments with respect to Crowell also can be found in the Appeal Brief and Supplementary Appeal Brief. Therefore, Applicant's Representative, in the interests of brevity, concisely describes the cited references and discusses why none of the cited references alone, or in any combination, either anticipate or make obvious the currently claimed invention. The discussion focuses on claim 1 as a representative claim, and applies generally to all of the claims currently pending in the current application.

Thompson

Thompson discloses a ticket envelope shown in Figures 1 and 2. The ticket envelope, prior to assembly, as shown in Figure 2 of Thompson, is a non-rectangular piece of paper with a protruding flap 20 and a pronounced, non-rectangular rear panel 16 protruding from a seemingly rectangular front panel 14 and closure panel 18. Thompson's ticket envelope includes "a sheet of material 44, such as glassine for example, of a generally rectangular configuration ... bonded to the inner face 24 of rear panel 16." (Thompson, column 2, lines 37-39). "The separate pocket is formed by cutting a slot in the panel which comprises one face of the usual ticket pocket and bonding a sheet of material on the inner face of such panel to provide a pocket within a pocket panel" (Thompson, column 1, lines 34-39). The protruding tab, or flap 20, is "adapted to be folded along fold line 36 into overlying relation with the bottom portion of the outer face of rear panel 16 when the latter has been folded against panel 14, and to be secured thereto by adhesive 38 to form a first pocket for receiving and retaining tickets therein" Thompson, column 2, lines 16-20). In summary, Thompson discloses a ticket envelope manufactured by bonding a glassine sheet to an irregularly shaped piece of paper, folding a rear panel onto a front panel, folding a flap onto the folded rear panel and bonding the flap with adhesive, and then folding a closing panel onto the front-panel/glassine/flap assembly. Thompson does not disclose the dimensions of the disclosed ticket envelope.

Skelton

Skelton discloses a single-sheet ticket envelope, as shown in Figure 1 of Skelton. Skelton's ticket envelope includes a number of between 3 and 9 panels (column 4, lines 65-67 and 24, 26, 28, 30, 32, 34, 36, 38, and 40 in Figure 1). Skelton's ticket envelope,

when unfolded, is not rectangular, instead including a protruding flap (43 in Figure 1) in all embodiments. Inspection of Figure 1 of Skelton clearly demonstrates that, as depicted, the protruding panel (43) would, in a three-panel embodiment, constitute fully 13% of the area of the three-panels, and would represent an excursion of fully 37% in the width of the rectangle formed by the three panels. Skelton does not include die-cut slots, a detachable registration form, or a registration form and key packet. Nowhere in Skelton are the dimensions of Skelton's foldable container disclosed.

Crowell

Crowell discloses a folded stationery piece with a three-dimensional pop-up message displayed along an internal fold line. The Examiner apparently cites only a portion of one sentence in Crowell, the full sentence stating that "[a]nother object of the invention is to provide a foldable card or sheet which is conveniently inserted in and typed upon by a typewriter or computer printer and then quickly decorated with a separate pop-up three-dimensional message-bearing insert adhesively secured to the card or sheet along an internal fold line" (column 2, lines 46-51). In essence, Crowell indicates that is an object of Crowell's invention that a card or sheet be first printed or typed, and an insert then adhesively affixed to it. Crowell's alternative embodiments include non-rectangular sheets and sheets with dye-cut pop-outs, but the only embodiment deemed potentially suitable for printing by Crowell is a card or sheet without the dye-cut pop-outs. Crowell never mentions this invention object again, and thus it remains a stated goal, rather than an affirmative statement of whether or not the goal is met, or by what considerations the goal may be deemed to have been met. Moreover, there is no indication of the dimensions or shape of an embodiment that might meet the stated object.

Claim 1

Claim 1 of the current application is provided below:

1. A rectangular, single-sheet registration form and key packet comprising:
 - a registration form;
 - an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and
 - one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

Claim 1 claims a "rectangular, single-sheet registration form and key packet." Thompson and Skelton both disclose ticket envelopes, and Crowell discloses novelty stationery. None of the cited references disclose a registration form, a key packet, or the claimed single-sheet, combined registration form and key packet. Thompson and Skelton disclose decidedly non-rectangular ticket envelope blanks. The described embodiments in Crowell are either rectangular, but include a separate, affixed insert (Crowell, column 4, lines 40-43 and Figure 1), or not rectangular (Figures 2 and 3). Thus, not one of the cited references discloses, teaches, mentions, or suggests anything comprising a rectangular, single-sheet. For this reason, alone, claim 1 is neither anticipated by any of the cited references nor made obvious by any combination of the cited references.

The first element of the body of claim 1 recites a registration form separated from an unfolded key packet by a line of perforations. None of the cited references discloses, teaches, mentions, or suggests a registration form, or any separate entity included along with a key packet on a single-sheet blank. For this reason, alone, claim 1 is neither anticipated by any of the cited references nor made obvious by any combination of the cited references.

The second element of the body of claim 1 recites unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps. Thompson requires a relatively complex assembly process involving separate sheets of different types of materials and at least three folding operations. Once Thompson is folded, the pocket constructed by gluing glassine (44 in Figure 2) to the back of a flap (34 in Figure 2), and affixing another flap (20 in Figure 2) to the front panel (14 in Figure 1) using adhesive (38 in Figure 2), Thompson still does not constitute a key packet, since the assembled pocket may be neither sufficiently stiff or properly dimensioned for holding either metallic keys or key cards. Skelton requires a minimum of three folds in a 3-panel embodiment, and, once folded, does not constitute a key packet, lacking a slot sufficient for holding a key. Crowell's embodiments appear to require either attachment of an insert by adhesives (Crowell, column 5, lines 21-26) or construction involving adhesives applied to tabs (Crowell, column 4, lines 44-46 and lines 54-56). Once constructed, Crowell's disclosed stationery provides no means for retaining a key. Thus, none of the cited references discloses, teaches, mentions, or suggests an unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps. Moreover, none of the cited references discloses a blank with two or fewer fold lines. For this reason, alone, claim 1 is neither anticipated by any of the cited references nor

made obvious by any combination of the cited references.

The third element of the body of claim 1 recites one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet. Thompson does feature a die-cut aperture, but it is an opening into a constructed pocket, the pocket holding a baggage-claim ticket, rather than the aperture. As clearly seen in Figures 1 and 2 of Thompson, the aperture is quite large, and by itself would be incapable of holding a key. Thompson clearly states, in column 2, lines 44-45, that slot 42 constitutes the mouth, or inlet, of the pocket, and explicitly states, in column 2, lines 73-74, that the pocket, rather than the slot, receives and retains the baggage claim stub. Neither Skelton nor Crowell disclose die cut slots suitable for retaining a key or any other object. Thus, none of the cited references discloses, teaches, mentions, or suggests one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet. For this reason, alone, claim 1 is neither anticipated by any of the cited references nor made obvious by any combination of the cited references.

In Applicant's representative's opinion, the three cited references are simply irrelevant to the claimed invention. The only link between the three cited references and the claimed invention is that they are paper products, and involve blanks that are assembled into a paper product. Furthermore, paper products is a huge and diverse category of products. Applicant's representative can find no convincing suggestion in any of the cited references, or in anything else stated or cited by the Examiner, for combining features of stationery novelties and ticket envelopes. Because the cited references disclose none of the claimed elements nor the claimed rectangular, single-sheet registration form and key packet, the lack of explicit or implicit suggestion for the combinations used in the rejections is, perhaps, not terribly relevant.

CONCLUSION

Applicant has made a significant investment in time and money in reducing the current invention to practice, bringing the current invention to market, and building a successful business around the current invention. That business has been under threat from infringement now for several years. The Current Application was filed early in the year 2000. The Examiner has introduced no new references or substantially new arguments to justify reopening prosecution, and continued prosecution appears to Applicant to only add further delay, without possibility for resolution. Applicant requests that the Appeal be reinstated in order to expedite passage of the Current Application to issuance.

Applicant respectfully submits that all statutory requirements are met and that the present application is allowable over all the references of record. In view of the already lengthy prosecution, the apparent inability of the Examiner to find relevant references during the course of 5 years, and the apparent unwillingness of the Examiner to substantively consider the Declaration and objective evidence of non-obviousness, Applicant respectfully requests that the present application be directly passed to issue, rather than returned to the Examiner for further prosecution.

Respectfully submitted,
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APPENDIX

A copy of the Declaration of Ted Eugene Wright is provided, on the following pages, with relevant portions bolded or bolded and underlined.